

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS AND INTERFERENCES**

In Re Application of:

Confirmation No.: 8529

Jerding, et al.

Group Art Unit: 2424

Serial No.: 09/693,790

Examiner: Shang, Annan Q

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Docket No. A-6689/60374.0004USC5

For: **Integrated Searching System For  
Interactive Media Guide**

**REPLY BRIEF UNDER 37 C.F.R. § 41.41**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
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Sir:

This is a Reply Brief in response to the Examiner's Answer dated May 14, 2009.

## **I. STATUS OF THE CLAIMS**

Claims 117-128, 130, 131, 149-163 and 165-187 remain pending in the present application. The Examiner's Answer maintains the rejections of the claims under 35 U.S.C. § 102(e) and 103(a) and generally repeats the arguments advanced in the Final Office Action dated July 25, 2008 along with providing additional comments (in the Response to Argument Section, beginning on page 9 of the Examiner's Answer) to the Appeal Brief, filed on February 13, 2009. With regard to the substantive remarks of the Examiner's Answer, Appellant respectfully disagrees. Although Appellant will address some issues raised in the Examiner's Answer, Appellant continues to repeat, re-allege, and incorporate by reference the positions and arguments set forth in the Appeal Brief.

## **II. ARGUMENTS**

Appellant addresses some of the rebuttal comments substantively beginning on page 10 of the Examiner's Answer below, and in particular, the rebuttal comments pertaining to what constitutes PVR-associated storage mediums as claimed in example independent claims 117 and 149 as it is believed that a substantial part of the dispute as to claim patentability revolves around proper claim construction pertaining to this feature shared in relevant part between at least claims 117 and 149. The omission of discussion pertaining to some issues raised in the Examiner's Answer should not be interpreted as an admission of the assertions made in the Examiner's Answer, and as set forth above, the rebuttal to the rejection of these and other claims (e.g., claim 171) set forth in the appeal brief are re-alleged and incorporated herein by reference.

The Examiner's Answer alleges the following on page 10 (emphasis added):

Appellant(s) has mischaracterized the Nishikawa reference, making reference to few various units for storing media programs and EPG or menu information. Nishikawa teaches a plurality of storage devices (Recording Device 'RD' 42 coupled via IEEE 1394 bus(es) to SDRAM, ROM, etc., HDD is coupled to flash

memory, SDRAM, etc., via bus(es)) that records media programs (TV programs, Internet data (web pages, video programs, etc.) and stores various sets of media information (see figs. 1-2). Nishikawa further teaches that DSS/WebTV Receiver 12, receives DSS/Internet data (EPG data, Internet data, etc.), stores the data in the various storage units to permit a user to access information (including web-sites data in time), periodically downloads the data (col. 6, lines 15-59) and further teaches that incoming data is stored in a selected memory location, HDD (hard disk), Memory 230, VCR, etc., (col. 7, line 44-col. 8, line 1, col. 9, lines 53-63).

Appellant respectfully disagrees that there has been a mischaracterization by Appellant of the reference, and further disagrees that the non-VCR devices disclosed in *Nishikawa* are PVR-associated storage mediums configured for recording. Appellant has fully acknowledged the disclosure of different storage devices in *Nishikawa* beyond the disclosed VCR, however, the claim language of independent claims 117 and 149, for instance, precisely and explicitly requires at least the following (emphasis added):

Claim 117: enabling a user to record a first set of media programs in a first storage device associated with a digital personal video recorder (PVR)

Claim 149: enabling a user to record in the memory a first set of media programs associated with a personal video recorder (PVR)

In other words, it is clear that claims 117 and 149 require the recording of media programs in a first storage device (or memory) associated with a PVR. Assuming *arguendo* the VCR of *Nishikawa* may be construed as a **PVR**, there are other reasons why the VCR does not meet the claim language of claims 117 and 149 (e.g., for claim 117, a VCR is not digital) as set forth in the Appeal Brief, and hence omitted here for purposes of narrowing the argument to what appears to be the gist of the Examiner Answer's contentions. In short, Appellant has made it clear in the Appeal Brief and prior responses that any and all teachings in *Nishikawa* of recording and PVR pertain to the VCR, and not the various storage devices that the Examiner's Answer seeks to construe into the claim language (presumably recognizing the impropriety of a

*prima facie* case of anticipation or obviousness rejection under 102 or 103, respectively, should there be exclusive reliance on the VCR as an alleged equivalent to the storage mediums associated with the PVR for the claim language).

The Examiner's Answer (page 12, in the discussion of arguments under claims 130-131, 162-163, and 186-187) comments that "Appellant is further reminded that a reference can be relied upon for all that would have reasonably suggested to one of ordinary skill in the art, including non-preferred/preferred embodiments." Assuming that assertion to be true, Appellant queries what *Nishikawa* would have reasonably suggested to one having ordinary skill in the art about the mechanisms involved with PVR-associated recording. In addition to a thorough review of the *Nishikawa* disclosure, Appellant has done a term search of "record" of *Nishikawa* and has reviewed the context to assure that it is reflective of recording functionality (versus a record of player stats for instance) in *Nishikawa*, and has reproduced the accompanying sections corresponding to the searched term below. Although it is believed that most if not all of the citations to "record" have been uncovered and presented below, Appellant does not guarantee that all usages of "record" have been reproduced below. Nevertheless, again assuming *arguendo* the VCR to be construed as a PVR, one having ordinary skill in the art should have reasonably come to the conclusion that recording of media programs in a storage device or other medium associated with PVR is exclusively the domain of the VCR in *Nishikawa*, and not the other storage devices as alleged by the Examiner's Answer in view of the results of that search reproduced below (emphasis added):

[Abstract] ...The GUI includes a TV Planner icon which, if selected by the user, causes the television to display a monthly calender (or recording/reminder list) that indicates which programs are purchased and/or selected for recording by a VCR. A "Purchase" icon appears adjacent purchased programs and a "Record" icon appears adjacent programs to be recorded. If the user selects "Purchase" icon, the user is visually presented (e.g., via a pull-down screen) with the cost, date, and time of the program purchased or to be purchased. If the user selects "Record" icon, the user is visually presented (e.g., via a pull-down screen) with the title, date, and time of the program to be recorded. The TV Planner screen also includes a "Timer & Rec." icon and a "Review Purchases" icon. If the user

selects "Timer & Rec." icon, the user is presented with a "Timer & Rec." screen that lists the programs that the user selected to view or record...

[claim 1] ...wherein the first circuit, in response to the user's selection of TV planner icon, generates a display on the television of a calendar that indicates only those programs that have been selected for recording, viewing and purchasing...

[claim 4] The apparatus of claim 3, wherein the first circuit, in response to the user's selection of the TV planner display icon, additionally causes the television to display a plurality of additional user selectable icons, including one or more of a purchase icon, a record icon, a review purchases icon, and a timer and recording icon.

[claim 5] The apparatus of claim 4, wherein purchase icon appears adjacent purchased programs and a record icon appears adjacent programs to be recorded.

[claim 7] The apparatus of claim 4, wherein the first circuit, in response to the user's selection of the record icon, causes the television to display a pop-up record screen that lists the title, date, and time of the program to be recorded.

[claim 8] The apparatus of claim 4, wherein the first circuit, in response to the user's selection of the record icon, causes the television to display a pop-up screen that lists the title, date, and time of one or more programs already recorded.

[claim 9] The apparatus of claim 4, wherein the first circuit, in response to the user's selection of the timer and recording icon, causes the television to display a pull-down timer and recording screen that lists the programs that the user has selected to view and/or record.

[claim 10] The apparatus of claim 9, wherein the user can modify selected data in the timer and recording screen.

[claim 14]...wherein the first circuit, in response to the user's selection of TV planner icon, generates a display on the television of a calendar that indicates only those programs that have been selected for recording, viewing and purchasing...

[claim 17] The method of claim 14, further comprising the step, in response to the user's selection of the TV planner display icon, of additionally causing the

television to display a plurality of additional user selectable icons, including one or more of a purchase icon, a record icon, a review purchases icon, and a timer and recording icon.

[claim 18] The method of claim 17, wherein the purchase icon appears adjacent purchased programs and a record icon appears adjacent programs to be recorded.

[claim 20] The method of claim 17, further comprising the step, in response to the user's selection of the record icon, of causing the television to display a pop-up record screen that lists the title, date, and time of the program to be recorded.

[claim 21] The method of claim 17, further comprising the step, in response to the user's selection of the record icon, of causing the television to display a pop-up screen that lists the title, date, and time of one or more programs already recorded.

[claim 22] The method of claim 17, further comprising the step, in response to the user's selection of the timer and recording icon, of causing the television to display a pull-down timer and recording screen that lists the programs that the user has selected to view and/or record.

[claim 23] The method of claim 22, wherein the user can modify selected data in the timer and recording screen.

[col. 1, lines 13-22] Over the last few years there has been a growing demand for entertainment systems that facilitate a user's ability to access multiple broadcast, information, and entertainment mediums. One type of broadcast medium is a broadcast satellite system such as a digital satellite system (DSS). DSS typically includes an antenna, an integrated receiver decoder (IRD), a television receiver (TV), and a remote controller. DSS may additionally include an analog video cassette recorder (VCR) that receives analog data for recording purposes.

[col. 1, line 59 – col. 2, line 5] To address the shortcomings of the available art, the present invention includes an integrated DSS/WebTV receiver that is communicatively connected to an Internet service provider, a DSS service provider, and (optionally) a local broadcast station to provide a display of DSS programs, Internet web sites, and local broadcast channels in a seamless fashion. The DSS/WebTV receiver generates a graphical user interface (GUI), displayed on a television screen, for facilitating a user's navigation through the DSS, Internet, and local broadcast data. The GUI includes a TV Planner icon which, if selected by the user, causes the television to display a monthly calender (or recording/reminder list) that indicates which programs are purchased and/or selected for recording by a VCR.

[col. 2, lines 6-17] A "Purchase" icon appears adjacent purchased programs and a "Record" icon appears adjacent programs to be recorded. If the user selects "Purchase" icon, the user is visually presented (e.g., via a pull-down screen) with the cost, date, and time of the program purchased or to be purchased. If the user selects "Record" icon, the user is visually presented (e.g., via a pull-down screen) with the title, date, and time of the program to be recorded. The TV Planner screen also includes a "Timer & Rec." icon and a "Review Purchases" icon. If the user selects "Timer & Rec." icon, the user is presented with a "Timer & Rec." screen that lists the programs that the user selected to view or record.

[col. 3, lines 43-60] Referring now to FIG. 1, an exemplary embodiment of an entertainment system 10 utilizing the present invention is shown. Entertainment system 10 includes an integrated DSS/WebTV receiver 12, a remote controller 14, and a display monitor such as a television receiver (TV) 16. Integrated receiver 12 includes an input port 18 that receives broadcast signals from a DSS antenna 20, an I/O port 22 that receives Internet data over a telephone line 23 from an Internet service provider 24, an input port 26 that receives broadcast signals from a local programming station 28 (e.g., a local cable station), and an infrared receiver 13 for receiving infrared signals from the remote controller 14. Integrated receiver 12 also includes peripheral I/O ports 30 that communicate with a plurality of peripheral devices 32. Peripheral devices 32 include, but are not limited to, a scanner 34, a printer 36, a keyboard 38, a microphone 40, and a recording device 42 such as video cassette recorder (VCR).

[col. 8, lines 7-19] Turning now to FIG. 2C, a simplified block diagram of the internal routing of video signals in integrated DSS/WebTV receiver 12 is illustrated. There are three sources for the video signals input to integrated DSS/WebTV receiver 12: video signals received via DSS antenna 20, video signals received from a peripheral device (e.g., a camcorder or other video recording device) via peripheral bus interface 212, and video signals received from terrestrial tuner 236. The DSS and peripheral device video signals are processed (decoded, decompressed, etc.) by DSS processing element 200 and relayed to Buffer logic 204. The terrestrial video signals are converted to a digital format by digital to analog converter 240 and relayed to Buffer logic 204.

[col. 13, lines 19-36] If "TV Planner" icon 558 is selected, DSS processing element 200 generates a full screen display of a TV Planner screen 632, as shown in FIG. 11. TV Planner screen 632 includes a monthly calender (or recording/reminder list) 610 that indicates which programs are purchased and/or selected for recording by VCR 42 (FIG. 1). A "Purchase" icon 634 appears adjacent purchased programs and a "Record" icon 636 appears adjacent programs to be recorded. If the user selects "Purchase" icon 634, the user is visually presented (e.g., via a pull-down menu) with the cost, date, and time of the purchased program. If the user selects "Record" icon 636, the user is visually presented (e.g., via a pull-down menu) with the title, date, and time of the program to be recorded. TV Planner screen 632 also includes a "Timer & Rec." icon 612 and a "Review Purchases" icon 614. If the user selects "Timer & Rec."

icon 612, the user is presented with a "Timer & Rec." screen (not shown) that lists the programs that the user selected to view or record.

As evidenced from the above citations from *Nishikawa*, to assert that *Nishikawa* somehow teaches recording in a device other than the VCR is clearly without support. That is, there is no disclosure or suggestion in *Nishikawa* of the "other storage devices" being suitable for, or otherwise operating as, the recording medium associated with a PVR. Indeed, a review of the specification of *Nishikawa* fails to uncover any language of digital recording or the use of digital alternatives to the VCR, and hence to ascribe to the other storage devices the claim language pertaining to recording and PVR is neither explicitly (or implicitly) disclosed nor obvious.

For instance, merely storing data is not the same as recording data. To construe the claim language otherwise (i.e., to attempt to equate any storage device to one dedicated to PVR functionality) would not only ignore the distinct usage and recital of store and record (and the like) in the claims, but also ignore Appellant's disclosure (e.g., see page 6 of the originally filed application) and the teachings of *Nishikawa* (both of which treat differently the terms "store" and "record" (or the like) and distinguish mere storage devices from those associated with PVR functionality) in violation of claim construction principles mandated by Federal case law. Indeed, it most certainly is a mischaracterization of *Nishikawa* to allege that *Nishikawa* discloses or suggests that the HDD or other storage devices are recording devices associated with a PVR. For at least the reason that there is a clear lack of support for the allegation that other storage devices in *Nishikawa* may act as PVR-associated storage mediums, Appellant respectfully requests, to the extent that the non-VCR storage devices of *Nishikawa* are relied upon for the recording/PVR claim features, that the rejection be overturned.



### **III. CONCLUSION**

Based upon the foregoing discussion, the Appellant respectfully requests that the Examiner's final rejection of claims 117-128, 130, 131, 149-163 and 165-187 be overruled and withdrawn by the Board, and that the application be allowed to issue as a patent with all pending claims.

No additional fee is believed to be due. However, any additional fee that may be due or required is authorized to be charged to deposit account no. 13-2725.

Respectfully submitted,

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